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PATENTREMARKS

This Response addresses the final Office Action mailed July 11, 2002. New claim 26 is added. No new matter is added by claim 26. Claim 26 is supported in the application as originally filed at page 10, lines 5-19 and page 13, lines 27-29. Claims 15-19 and 21-26 are pending.

Interview Summary

On August 29, 2002, Applicant's undersigned representative, Kate DeVries Smith, conducted an interview summary with Examiner Stephen Castellano. The content of prior art references Barnes, Kimura, and Gallegos were discussed. No agreement was reached on the claims.

Withdrawal of the Finality of the Final Office Action

New grounds of rejection based on new prior art references were included in the final office action. Applicant respectfully requests that the finality of the office action be withdrawn to give the Applicant an opportunity to address these new rejections.

Regarding when a final rejection is proper on the second action, MPEP 706.07(a) states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) . . .

Four new grounds of rejection were made in the final office action:

1. Claims 15-18 and 21-23 over Kimura in view of Barnes
2. Claims 15-19 and 21-25 over Kimura in view of Barnes and Yellin
3. Claims 15-19 and 21-25 over Gallegos in view of Barnes (previously these claims were rejected over Barnes in view of Gallegos)
4. Claims 15-19, 21, 22, 24-25 over Gallegos in view of Barnes and Yellin

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Neither of the conditions found in MPEP 706.07(a) has been met for making the action mailed July 11, 2002 final, since new grounds of rejection were introduced in that action. First, the new grounds of rejection were not necessitated by the Applicant's amendment. The only amendment made to independent claim 15 in the Amendment filed May 16, 2002 was to change the wording of the preamble. Second, none of the references used in the new grounds of rejection were cited by the Applicant in an information disclosure statement filed under 37 CFR 1.97(c).

Therefore, Applicant respectfully requests the withdrawal of the finality of the office action mailed July 11, 2002, and the entry of the amendments filed herewith.

Rejections under 35 U.S.C. § 112

Claims 15-19, 21 and 25 were rejected under 35 U.S.C. § 112 as indefinite because the term "hollow region" appeared in both the preamble and the claim body of claim 15. Applicant has amended claim 15 so that the term hollow region is only introduced in the claim body, making it clear that this term refers to the region defined between the inner and outer containers.

Rejections under 35 U.S.C. § 103

Claims 15-19 and 21-25 have been rejected under 35 U.S.C. §103(a) for obviousness over combinations of five different references. A *prima facie* case of obviousness has four parts:

- a. There must be some suggestion or motivation to combine the prior art.
- b. There must be a reasonable expectation of success of the combination.
- c. The prior art references, when combined, must teach or suggest all claim limitations.
- d. Both the teaching or suggestion to make the combination and the reasonable expectation of success must be found in the prior art, and not in the applicant's disclosure. MPEP 2142; *In re Vaeck*, 947 F.2d. 488, 493 (Fed. Cir. 1991).

Applicant respectfully submits that none of rejections in the Office Action meet all four prongs of this test. Therefore, they should be withdrawn. Applicant respectfully traverses each rejection.

Rejections over Kimura In View of Barnes

Claims 15-18 and 21-23 were rejected as being unpatentable over U.S. Patent No. 5,553,735 to Kimura ("Kimura") in view of U.S. Patent No. 5,674,546 to Barnes et al. ("Barnes"). Claim 15 teaches a decorative container system for displaying items in a hollow region comprising a decorative container with a hollow region between an outer container and an inner container, a removable member allowing access to the hollow region and a decorative lid shaped to be removably mounted in an upper opening of the decorative container. The outer container of claim 15 is at least partially transparent.

Kimura relates to a drinking vessel for holding a liquid including an outer shell and an inner shell, forming a cavity between the two shells. (Kimura, Abstract.) As acknowledged in the office action, Kimura does not show a decorative lid. Barnes discloses a package for selling omelet ingredients that can also be used for cooking the omelet in a microwave oven. The Office Action argues that the upper container 10 of Barnes that holds omelet filling ingredients teaches a decorative lid, and argues that it would have been obvious to add the upper container 10 of Barnes to the container of Kimura.

Applicants respectfully traverse this rejection and reasoning. First, the references are non-analogous and it would not be obvious to one of skill in the art to combine them. Second, there is no motivation found in the prior art for combining the drinking glass of Kimura with the upper container having a cavity for omelet ingredients of Barnes.

This combination would not be obvious to one of skill in the art because the vessel of Kimura is a reusable drinking glass while Barnes describes an omelet cooking container for one-time use that makes omelets a more convenient food to cook in the microwave. The Kimura drinking vessel is preferably made of plastic injection molded material, and is washable and reusable. (See Kimura, Col. 2, lines 43-47.) The omelet cooking container of Barnes on the other hand is designed for one-time use and is made of disposable materials like paperboard, paperboard-polymer laminates, foamed plastic, or polystyrene that are not suited for washing and reuse. (Barnes, Col. 6, lines 11-24.) The upper container 10 of Barnes is clearly designed for one-time use as it is closed with

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a sealing foil 16 that is adhered to the upper sealing flange of the upper container 10 with an adhesive releasable seal. Because Kimura describes a washable drinking glass while Barnes describes a disposable microwave-cooking container for one-time use, it would not be obvious to combine Kimura and Barnes.

In addition, there is no motivation to combine the references found in the prior art. The Examiner argues that it would have been obvious to add the upper container of Barnes to the vessel of Kimura in order to "close the container and seal the contents from contamination." While it is not uncommon for drinking vessels to be provided with lids, the Examiner has not presented any motivation for adding an upper container having a cavity to a drinking vessel. The upper container 10 of Barnes holds the omelet inlay ingredients in a separate container from the liquid egg for the omelet. The purpose of the cavity of the upper container 10 is to hold the omelet inlay ingredients, and the presence of the cavity does not contribute to sealing the lower container or sealing it from contamination. The Examiner has presented no motivation found in the prior art for modifying the drinking vessel of Kimura to add an upper container with a cavity.

For these reasons, claim 15 is patentable over Kimura in view of Barnes, and therefore dependent claims 16-19 and 21-26 are also patentable for at least the same reasons.

Claim 26 is further patentable over Kimura in view of Barnes because claim 26 specifies that the decorative lid access member is replaceable in the decorative lid. In contrast, the sealing foil 16 of Barnes which provides access to the interior of the upper container 10 of Barnes is attached with adhesive and is not described as being resealable.

Rejections over Kimura In View of Barnes and Yellin

Claims 15-19 and 21-25 were rejected as being unpatentable over Kimura in view of Barnes and U.S. Patent to Yellin ("Yellin"). Applicant respectfully traverses this rejection. The Office Action states that the combination of Kimura and Barnes is the same as taught in the first rejection, discussed above, and that Yellin is relied upon to teach the dividers of claims 19 and 24-25. As argued above, the combination of Kimura

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and Barnes is not obvious, so this rejection should be withdrawn for the same reasons as discussed above.

Rejections Over Gallegos In View of Barnes

Claims 15-18, 21 and 22 were rejected as being unpatentable over U.S. Patent No. 5,275,277 to Gallegos ("Gallegos") in view of U.S. Patent No. 5,674,546 to Barnes et al. ("Barnes"). Barnes discloses a package for omelet ingredients that can also be used for cooking the omelet and Gallegos discloses a novelty drinking glass.

The office action argues that Gallegos teaches the invention except for the decorative lid. The office action argues that it would have been obvious to modify Gallegos to add the upper container of Barnes in order to "close and seal the contents from contamination." Applicants respectfully traverse this rejection. This rejection is not proper for the same reasons that the rejection over Kimura and Barnes is not proper:

1. The references are non-analogous and it would not be obvious to one of skill in the art to combine them.
2. There is no motivation found in the prior art for combining the drinking glass of Gallegos with the upper container having a cavity of Barnes.

This combination would not be obvious to one of skill in the art because, similar to the drinking vessel of Kimura, the drinking glass of Gallegos is a reusable drinking glass while Barnes describes an omelet cooking container for one-time use that makes omelets a more convenient food to cook in the microwave. The Gallegos drinking glass is preferably reusable and of "durable and reliable construction." (See Gallegos, Col. 2, lines 35-37.) The omelet cooking container of Barnes on the other hand is designed for one-time use and is made of disposable materials, as discussed above. (Barnes, Col. 6, lines 11-24.) Because Gallegos describes a durable, reusable drinking glass while Barnes describes a microwave-cooking container for one-time use, it would not be obvious to combine Gallegos and Barnes.

In addition, there is no motivation to combine Gallegos and Barnes found in the prior art. The Examiner argues that it would have been obvious to add the upper container of Barnes to the glass of Gallegos in order to "close the container and seal the contents from contamination." While it is not uncommon for drinking glasses to be provided with lids, the Examiner has not presented any motivation for adding an upper container having a cavity to a drinking vessel. The upper container 10 of Barnes holds the omelet inlay ingredients in a separate container from the liquid egg for the omelet. The purpose of the cavity of the upper container 10 is to hold the omelet inlay ingredients, and the presence of the cavity does not contribute to sealing the lower container or sealing it from contamination. The Examiner has not presented any motivation found in the prior art for modifying the drinking glass of Gallegos to add the upper container of Barnes, as opposed to a conventional lid.

For these reasons, claim 15 is patentable over Gallegos in view of Barnes, and therefore dependent claims 16-19 and 21-26 are also patentable for at least the same reasons.

Claim 26 is further patentable over Gallegos in view of Barnes because claim 26 specifies that the decorative lid access member is replaceable in the decorative lid. In contrast, the sealing foil 16 of Barnes that provides access to the interior of the upper container 10 of Barnes is attached with adhesive and is not described as being resealable.

Rejections Over Gallegos In View of Barnes and Yellin

Claims 15-19, 21, 22, 24 and 25 were rejected as being unpatentable over Gallegos in view of Barnes and further in view of Yellin. The office action cites that the combination of Gallegos and Yellin is the same as taught by the rejection of claims 15-18, 21 and 22 over Gallegos in view of Barnes. Therefore, this rejection simply addresses the removable dividers of claim 19 and 24-25 as being taught by Yellin. Applicant respectfully traverses this rejection. As argued above, the combination of Gallegos and Barnes is not obvious, so this rejection should be withdrawn for the same reasons as discussed above.

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PATENTRejections Over Barnes In View of Gallegos

Claims 15-18 were rejected as being unpatentable over U.S. Patent No. 5,674,546 to Barnes et al. ("Barnes") in view of U.S. Patent No. 5,275,277 to Gallegos ("Gallegos"). Barnes discloses a package for omelet ingredients that can also be used for cooking the omelet and Gallegos discloses a novelty drinking glass.

This same rejection was presented in the first office action dated January 16, 2002. In response to this rejection, Applicant submitted arguments and case law showing that the combination of Barnes and Gallegos was unworkable, illogical and not obvious. Applicant hereby incorporates the arguments against the combination of Barnes and Kimura described in the previous response filed May 16, 2002

The Examiner's only response to the Applicant's arguments against the combination of Barnes and Gallegos was to state that if the insulation material 22A of Barnes were modified to be a transparent material such as glass or clear plastic, that these materials would still provide at least some insulative effect. However, this does not address one of the main points of the arguments: that one of skill in the art is taught away from making a change that would reduce the effectiveness of the insulation material 22A by Barnes, because insulation is the only purpose of the insulation layer 22A. In addition, the Examiner did not address the other aspects of the response to this rejection:

1. The motivation presented for modifying Barnes to provide changeable decorations is illogical in view of the fact that Barnes teaches a disposable, one-use food container;
2. Barnes teaches away from modifying its package because changeable foreign objects in a cavity could allow the introduction of material that would interfere with microwave cooking; and
3. Barnes and Gallegos are non-analogous art.

In the Telephone Interview, the Examiner also did not provide a substantive response to the Applicant's arguments.

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PATENTRejections Over Barnes In View of Wilkinson

Claims 15-19 were rejected over Barnes in view of U.S. Patent No. 3,378,134 to Wilkinson et al. ("Wilkinson"), which discloses a compartmentalized fishing tackle container. Applicants respectfully traverse this rejection. This same rejection was presented in the first office action dated January 16, 2002. In response to this rejection, Applicant submitted arguments and case law showing:

1. The combination of Barnes and Wilkinson does not teach the removable member of claim 15;
2. There is no motivation to combine Barnes and Wilkinson;
3. Barnes teaches away from the combination of Barnes and Wilkinson; and
4. Barnes and Wilkinson are non-analogous references that would not be combined by one of skill in the art.

Applicant hereby incorporates the arguments against the combination of Barnes and Wilkinson described in the previous response filed May 16, 2002. The Examiner's only response to the Applicant's arguments against the combination of Barnes and Wilkinson was to argue that Wilkinson discloses a joint between the top wall 23 and the inner cylindrical wall 17 that can be "cut or otherwise disconnected" to allow access to the container. The Examiner's rejection relies on cutting apart the fishing lure container of Wilkinson to provide access to the container, when access is already provided by the access openings 7 and 8 in the side of the container. The Examiner did not provide motivation from the prior art for cutting the joint between the top wall 23 and the inner cylindrical wall 17 of Wilkinson. Therefore, applicant maintains the assertion that the combination of Barnes and Wilkinson does not teach the removable member of claim 15.

For this reason and the three other reasons summarized above, claim 15 is patentable over the cited references. Claims 16-19 are dependent on claim 15 and are patentable for at least the same reasons.

Rejections Over Barnes In View of Gallegos and Wilkinson

Claim 19 was also rejected over Barnes in view of Gallegos as applied to claim 15 and in further view of Wilkinson. Applicants respectfully traverse the rejection. For the

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reasons discussed above, Applicant submits that the combination of Barnes and Gallegos does not teach the decorative container of claim 15, which is the base claim for claim 19. As a result, the basis for the rejection of claim 19 is flawed for the reasons discussed above.

In addition, all the claimed elements are not taught by the combination of Barnes, Gallegos and Wilkinson because Wilkinson does not teach the claimed dividers. The dividers of Wilkinson are secured to the top wall 23 of the fishing tackle container. The Examiner does not explain precisely how he envisions the dividers being integrated into the alleged Barnes/Gallegos combination. However, it is clear that the dividers of Wilkinson are fixed to the top wall 23, as discussed above. As a result, removing the top wall 23 from Wilkinson results in removal of the core 16, including the dividers, in Wilkinson. Therefore, once the top wall 23 is removed, there is no hollow region defined between an inner container and an outer container. Therefore, Wilkinson does not teach dividers in a hollow region where a removable access member allows access to the hollow region. For at least these reasons, claim 19 is patentable over Barnes, Gallegos and Wilkinson.

These arguments were presented in the previous response filed May 16, 2002. The Examiner did not respond to this argument in the second office action.

Conclusion

In view of the above, favorable reconsideration and Notice of Allowance is requested. The Examiner is invited to telephone the undersigned at (612) 336-4710 if there are any issues that prevent the allowance of this application.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE IN THE CLAIMS

Claim 15 has been amended as follows:

15. (Twice Amended) A decorative container system for displaying items [in a hollow region] comprising:

a decorative container comprising an upper opening and an inner container positioned within an outer container thereby defining a hollow region therebetween, wherein the outer container is at least partially transparent;

a removable member allowing access to the hollow region; and

a decorative lid shaped to be removably mounted in the upper opening of the decorative container, the decorative lid defining a hollow lid cavity and being at least partially transparent, the lid further comprising a removable lid access member providing access to the hollow lid cavity.

New claim 26 has been added.